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Supreme Court of the United States

OCTOBER TERM 1975

No. 75-1358

LOUIS W. PARKER,

Petitioner,

v.

MOTOROLA, INC.,

Respondent.

PETITION FOR RE-HEARING OF PETITION FOR WRIT OF CERTIORARI

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TABLE OF CONTENTS

	Page
CERTIFICATE	ii
PETITION FOR RE-HEARING	1
PERTINENT ART	2
CROSS EXAMINATION	3
CONCLUSION	7

TABLE OF AUTHORITIES

Cases:

Dann v. Johnston, decided March 31, 1976, Case No. 74-1033 United States Supreme Court, ____ US ____	4,5
Graham v. John Deere Co., 303 U.S. 1, 17	1,2,3,5,6
Massey v. United States, 291 U.S. 608	5
Sanitary Refrigerator Co. v. Winters, 280 U.S. 30, 34, footnote 1	5
Sakrida v. Ag Pro Inc., decided April 20, 1976, Case No. 75-110, United States Supreme Court, ____ US ____	3,4,5,6
Schribner-Schroth Co. v. Cleveland Trust Co., 305 U.S. 47, 50	2,3,5
United States v. E.I. du Pont de Nemours & Co., 351 U.S. 377 (1956)	3

Statutes and Authorities:

35 U.S.C.A. 101	3
Rule 52, Federal Rules of Civil Procedure	6
Rules 611, 705, 706 and 806 of Federal Rules of Evidence	5
District Court Finding 32	2

CERTIFICATE

The undersigned counsel certifies that this Petition for Re-Hearing is presented in good faith and not for delay. Further, counsel certifies that this petition is restricted to the grounds allowed under the Rules of the Supreme Court, that is, there are substantial grounds available to petitioner although not previously presented, and there are intervening circumstances of a substantial and controlling effect.

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PETITION FOR RE-HEARING

This petition for re-hearing is filed under Rule 58 of the Rules of the Supreme Court of the United States. This petition is based on two issues:

1) Whether or not the pertinent art referred to in the case of *Graham v. John Deere Co.* 303 U.S. 1, 17 in the requirement that the level of ordinary skill in the pertinent art be resolved is defined separately by each claim, and

2) Whether or not the petitioner has a fundamental right to cross examine those introducing factual inferences into evidence.

1. Pertinent Art

A substantial ground available to the petitioner although not previously presented *Schribner-Schroth Co. v. Cleveland Trust Co.* 305 U.S. 47, 50) is that (a) the District Court in this case defined the pertinent art as the "... (person skilled in) the art of *intercarrier television receivers.*" (emphasis added), Finding 32[1] of the Trial Court and (b) the United States Court of Appeals, Fifth Circuit did not deny the District Court's definition of the pertinent art, but did use as pertinent art non-teaching documentary evidence in the radio field generally outside of the intercarrier television receiver art.

The case law does not appear to define what constitutes the *pertinent art* as set forth in the basic factual inquiry "the level of ordinary skill in the pertinent art", *Graham v. John Deere Co.*, supra. The patent bar is at a loss without a specific definition. Such a definition is urgently needed in order to define the pertinent art required so that "the level of ordinary skill in the pertinent art" can be properly resolved. This court has a rare and unique opportunity to remove the extreme confusion now prevailing in patent law by defining what is meant by the pertinent art. Is the pertinent art defined by each patent claim as the

[1] The subject matter in this suit, in reference to the prior art cited and the testimony given, taken either individually, or collectively as a whole, was such as to render the invention and claims 3, 5, 14 and 17 of the patent in suit unobvious at the time of filing of the patent in suit to a person skilled in the art of intercarrier television receivers.

BLEED THROUGH

District Court did in this case, or is the pertinent art defined by the scope of the patent specification as the Court of Appeals did in this case.[2]

At the root of the definition of *pertinent art* is the basic question of whether or not *narrow patent grants and claims* may also be issued to advance the technology in older, well developed technical arts in order to continue to promote the technical advancement of older arts step by step. If the patent system is without narrow patents, who will be encouraged to endeavor and toil in the older technical arts for improvements under 35 USC 101.[3]

2. Cross Examination

This petition is also based upon the petitioner's fundamental right to cross examination in regard to those presenting factual evidence that is relied upon in the decision making process. This is a substantial ground not previously presented, *Schribner-Schroth Co. v. Cleveland Trust Co.* supra. The intervening decision by this court in *Sakrida v. Ag Pro Inc.* on April 20, 1976, Case No. 75-110, United States Supreme Court, ____ US ____ properly held and reemphasized by a

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[2]This is analogous to the necessity for the definition of "Product Market" in Antitrust Law as set forth in the case of *United States v. E.I. du Pont de Nemours & Co.*, 351 U.S. 377 (1956).

[3]"... whoever invents or discovers any new and useful process, machine, manufacture or composition of matter or any new and useful *improvement* thereof..." (emphasis added)

vivid example that factual evidence must be presented at the trial *as to the level of ordinary skill in the pertinent art* as required by *Graham v. John Deere Co.*, supra. Under 35 USC 103 the level or ordinary skill must be "at the *time* of the invention. . ." (emphasis added). This honorable court in the *Sakrida v. Ag Pro Inc.* supra, decision reemphasized the requirement that *evidence* must be present to resolve or show the level of ordinary skill in the art. In the absence of evidence as to the level of ordinary skill in the pertinent art at the time of the invention, the question of law, obviousness or non-obviousness, cannot be determined. Such evidence must be presented at trial by the party alleging invalidity of a patent. Since there is no such defensive evidence in the trial record in this case and only petitioner's concrete evidence, the creation of such evidence or the inferring of such evidence must have been made outside of the trial record. The creation or inferring of factual evidence outside the trial record denies the petitioner his fundamental right to cross examination.

This court noted in the *Sakrida v. Ag Pro Inc.* supra, decision, that its independent examination of the evidence revealed among other evidence, that Mr. Gribble referred to ". . . various means for flushing manure from dairy barns having been used long before the filing of the application for the Gribble patent." (footnote 6 of *Sakrida v. Ag Pro Inc.*). This graphically shows that factual evidence of level of ordinary skill was present in the pertinent art as defined by each claim.

Further, this court also properly held, among other things, in its recent decision in *Dann v. Johnston*,

BLEED THROUGH

decided March 31, 1976, Case No. 74-1033 in the United States Supreme Court, ____ US ____, that "... such a hypothetical person would have been aware both of *the nature of the extensive use* of data processing systems in the banking industry and *the system encompassing the Dirks patent.*" (emphasis added). This statement clearly shows that this court referred to factual trial record evidence of *the level of ordinary skill in the pertinent art* (at the time of the invention) as required by *Graham v. John Deere*, supra. This court did not infer factual evidence of the level of ordinary skill.

The petitioner has the fundamental right to cross examine witnesses and confront evidenciary inferences of fact at trial. This is evident in view of the two most recent and intervening cases, *Sakrida v. Ag Pro Inc.* supra, and *Dann v. Johnston* supra. These intervening cases have a substantial and controlling effect on the Petition for Writ of Certiorari in this case, see *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30, 34, footnote 1; *Massey v. United States*, 291 U.S. 608; and *Schribner-Schroth Co. v. Cleveland Trust Co.* supra. In this case the trial record only contains concrete evidence presented by the petitioner of *the level of ordinary skill in the pertinent art.* Therefore, the legal decision by the United States Court of Appeals for the Fifth Circuit is blatently incorrect. One of the three factual criteria required for decision making in regard to obviousness or non-obviousness is totally absent from the trial record.

The United States Court of Appeals for the Fifth Circuit made a *factual inference* not supported by the trial record. Factual inferences made by the court not

contained in the trial record deny the petitioner his right of cross examination. This is in direct violation of Rule 611, 705, 706 and 806 of the Federal Rules of Evidence for United States Courts and Magistrates, a codification of the common law rights in civil trials that are preserved under the Seventh Amendment to the Constitution of the United States.

Therefore, the United States Court of Appeals for the Fifth Circuit clearly and without justification introduced new factual, inferred evidence into this case, inferred solely from non-teaching documents. Non-teaching documents cannot be the basis of proper inferences except through an in-court expert. The introduction of new factual inferences denies the petitioner his right to cross examination under the Federal Rules of Evidence, violates the requirements under *Graham v. John Deere* supra, and violates Rule 52 of the Federal Rules of Civil Procedure.

The recent *Sakrida v. Ag Pro Inc.* supra case states clearly that it requires factual defensive evidence of the level of the ordinary skill in the art. Finding 32 of the District Court that deals with the level of the art is based on concrete trial evidence both documentary evidence and testimony. The petitioner presents this court with a unique opportunity to make it precisely clear that factual documentary evidence or factual inferred evidence through witness of the level of ordinary skill in the art must be presented at trial, as this petitioner did by clear and concise documentary evidence and testimony. Non-teaching patents and publications of a highly technical art either singularly or collectively do not present evidence or do not of themselves infer factual evidence that fulfills the

BLEED THROUGH

requirement for a factual determination of the level of the ordinary skill in the pertinent art at the time of the invention. If the Court draws inferences from non-teaching references, it creates *new factual evidence*, which it must not do. The level of ordinary skill in the art may not be inferred by the Court of Appeals since it is not *one skilled in the art at the time of the invention* that can properly make such an inference nor is the Court of Appeals a trial witness.

CONCLUSION

Certiorari should be granted to clarify the criteria for pertinent art (so that technical advancements in the older arts may also be encouraged for the benefit of the public), and to forbid resort to inferences instead of factual evidence.

Respectfully submitted,

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